

TRANSMITTAL FORM

Attorney Docket No.
FN010/2725CIPIn re the application: **Eran STEINBERG**Confirmation No.: **3485**Serial No: **09/313,131**Group Art Unit: **2612**Filed: **May 17, 1999**Examiner: **Nguyen, Luong Trung**For: **In Camera Messaging and Advertisement System**

ENCLOSURES (check all that apply)

<input type="checkbox"/>	Amendment/Reply	<input type="checkbox"/>	Assignment and Recordation Cover Sheet	<input type="checkbox"/>	After Allowance Communication to Group
<input type="checkbox"/>	After Final	<input type="checkbox"/>	Part B-Issue Fee Transmittal	<input type="checkbox"/>	Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/>	Information disclosure statement	<input type="checkbox"/>	Letter to Draftsman	<input checked="" type="checkbox"/>	Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/>	Form 1449	<input type="checkbox"/>	Drawings	<input type="checkbox"/>	Status Letter
<input type="checkbox"/>	(X) Copies of References	<input type="checkbox"/>	Petition	<input checked="" type="checkbox"/>	Postcard
<input type="checkbox"/>	Extension of Time Request *	<input type="checkbox"/>	Fee Address Indication Form	<input type="checkbox"/>	Other Enclosure(s) (please identify below):
<input type="checkbox"/>	Express Abandonment	<input type="checkbox"/>	Terminal Disclaimer		
<input type="checkbox"/>	Certified Copy of Priority Doc	<input type="checkbox"/>	Power of Attorney and Revocation of Prior Powers		
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<input type="checkbox"/>	Response to Missing Parts	*Extension of Term: Pursuant to 37 CFR 1.136, Applicant petitions the Commissioner to extend the time for response for xxxxxx month(s), from to .			
<input type="checkbox"/>	Executed Declaration by Inventor(s)				

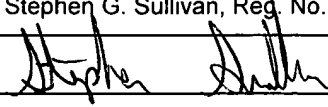
CLAIMS

FOR	Claims Remaining After Amendment	Highest # of Claims Previously Paid For	Extra Claims	RATE	FEE
Total Claims	19	52	0	\$18.00	\$ 0.00
Independent Claims	2	4	0	\$86.00	\$ 0.00
				Total Fees	\$ 0.00

METHOD OF PAYMENT

<input checked="" type="checkbox"/>	Check no. 8028 in the amount of \$330.00 is enclosed for payment of appeal fee.
<input type="checkbox"/>	Charge \$ _____ to Deposit Account No. _____ (Account Holder Name) for payment of fees.
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Attorney Name	Stephen G. Sullivan, Reg. No. 38,329
Signature	
Date	August 26, 2004

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPEAL NO:

In Re Application of: Eran STEINBERG

Confirmation No.: 3485

Serial No. 09/313,131

Filed: May 17, 1999

For: IN CAMERA MESSAGING AND ADVERTISEMENT SYSTEM

APPELLANT'S BRIEF

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CERTIFICATE OF MAIL

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Jinry Nguyen

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:

Date: August 26, 2004

Eran STEINBERG

Confirmation No.: 3485

Serial No.: 09/313,131

Group Art Unit: 2612

Filed: May 17, 1999

Examiner: Nguyen, Luong Trung

For: IN CAMERA MESSAGING AND ADVERTISEMENT SYSTEM

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P. O. Box 1450
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APPELLANT'S BRIEF ON APPEAL

Sir:

Appellant herein files an Appeal Brief drafted in accordance with the provisions of
37 C.F.R. § 1.192(c) as follows:

I. REAL PARTY IN INTEREST

Appellant respectfully submits that the above-captioned application is assigned, in its entirety to FotoNation Holdings LLC, Peterborough, New Hampshire.

II. RELATED APPEALS AND INTERFERENCES

Appellant states that, upon information and belief, he is not aware of any co-pending appeal or interference which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Application Serial No. 09/313,131 (the instant application) as originally filed included claims 1-52. In response to the Office Action dated 3/12/2002, Appellant added claims 53-59. Claims 1, 3-5, 11, 17-21, 30, and 53-59 are being appealed.

IV. STATUS OF AMENDMENT

An Amendment filed after the Final Office on April 23, 2004 was not entered by the Examiner. Therefore, the claims on Appeal are those filed in the Office Action dated August 27, 2003, which immediately preceded the Final Office Action.

V. SUMMARY OF THE INVENTION

The present invention provides a digital photography messaging and advertisement system wherein a message center maintains records of camera purchasers, and each corresponding camera identification (ID). The message center prepares and collects messages, putting them in categories including personal messages for a particular camera user, messages for all users of a particular interest group, and generic messages which can be advertisements for all users with cameras configured according to the system. Each camera is equipped with a transceiver for receiving and sending data, and a display for observing the messages or listening to them. Each camera subscribes to its own personal messages. In

addition, a camera user may subscribe to a single or multiple interest groups. When a user turns on the camera, the transceiver transmits a signal conveying the camera identification to the message center. In response, the center packages the messages that are identified for the particular camera user and transmits them along with a code that assures reception only by the specific camera. Alternatively, the messaging and advertisement center continuously transmits generic and user interest group messages. The camera receives the messages, and places them on a display. Interactive messages remain on the display until the user responds through activation of a key or key sequence on a camera keypad. In addition, the user can respond to the messages.

The present invention provides a camera vendor or retailer the ability to promote photo related advertisements, such as related photographic services, upgrades and models. A further advantage of the present invention is that messages received by the camera can be interactively responded to by the camera user, providing an immediate and convenient mechanism to respond to images.

VI. ISSUES

The issues presented are:

(1) whether claims 53-59 are each unpatentable under 35 U.S.C. §103(a) as being unpatentable over Itakura in view of Marinus et al. (US 5,606,365); and

(2) whether claims 1,3-5, 11, 17-21, 30 are each unpatentable under 35 USC §103(a) as being unpatentable over Reeley et al. (U.S. 5,893,037) in view of Ilcisin et al. (U.S. 5,880,770) in view of Itakura et al. (U.S. 6,351,745) and Hawkes (US 6,161,122).

VII. GROUPING OF CLAIMS

Appellant hereby states that claims 1, 3-5, 11, 17-21, 30 and 53-59 do not stand or fall together. Claims 53-59 form one group, and claims 1, 3-5, 11, 17-21, 30 form a second group.

VIII. ARGUMENTS

A. Summary of the Applied Rejections

The Final Office Action dated December 23, 2003, rejected claims 1,3-5, 11, 17-21, 30 under 35 USC §103(a) as being unpatentable over Reelee et al. (U.S. 5,893,037) in view of Ilcisin et al. (U.S. 5,880,770) in view of Itakura et al. (U.S. 6,351,745), and further in view of Hawkes (US 6,161,122); and rejected claims 53-59 were rejected under 35 USC §103(a) as being unpatentable over Itakura in view of Hawkes, and further in view of Marinus et al. (US 5,606,365).

Appellant respectfully requests that the Board reverse the Examiner's final rejection of the pending Claims.

B. The Cited Prior Art

Reele is directed to a combined electronic/film camera that is capable of transmitting electronic image data using a conventional cellular telephone. The system includes a camera and a separate cellular telephone that can be electrically coupled to the camera. The digital images captured by the camera are supplied to the cellular telephone, which transmits the digital image signals to a remote location (Abstract). The cellular telephone has a voice generator to provide the operator with audible voice messages indicative of various

operating conditions of the cellular telephone or camera. Messages can be communicated to the operator either by display or through use of the voice generator.

Ilcisin provides a messaging system wherein third party messages are displayed on video phones during the setup of a video phone call. When a calling party initiates a video phone call to a second party, an initial connection to a transmission system, a communications system sends messages in the form of video images for display on the video screen of the video phone. When connection is made to the videophone of the second party, messages are displayed on the display of the second party (col. 2, lines 49-60).

Itakura teaches a communication system for distributing messages and advertisements to the user's computer over the Internet. The computers are connected to an information provider, which in turn is connected to a pay system that includes a message distribution apparatus. The messaging distribution apparatus transmits the advertisements over the Internet, which are then received by a message manager in the information provider and stored in a message database. Software in the user's computer request messages from the message manager. (Col. 7, line 52 - Col. 8, line 21). When receiving a request, the message distribution apparatus retrieves information from a message user database, and searches for a message in the message database using the user information. (Col. 10, lines 48-52). The message is then sent to the computer over the network for display.

Hawkes discloses a computer architecture for providing information for customers on products being offered for sale at a facility, such as a retail location. The system includes a control computer located at the facility connected to a remote central computer system (Col. 4, lines 41-45). Speakers and buttons are distributed at locations throughout the facility or store where merchandise is being displayed (Col. 5, lines 49-43). A speaker map having an

address location for each speaker is stored in DRAM of the control computer. A message available list includes an address position for each message stored on a hard disk that correspond to the products (Col. 5, lines 65; Col. 6, lines 1-25). In operation, when a person presses a button for a speaker in the site, the message assigned to the channel or speaker is played. In a retail environment, such messages might be, for example, the warranty, promotions, and specifications, etc. (Col. 7, lines 1-32).

Maurinus teaches a high resolution still image camera system for use in conjunction with an interactive home information system (Col. 2, lines 46-49). The interactive network system provides distributed processing and storage of video frames and associated data in nodes disposed about a cable television distribution system. The system includes a user's camera coupled to a home interface control (HIC) or set-top box, and a remote headend computer or node coupled to the HIC. The user signs up for the service with the camera manufacturer, and an ID code of the user's camera is linked to the user's account. The camera manufacturer downloads correction codes and processing algorithms with the camera ID to the headend computer. The user then uploads raw, digitized image information from the camera to the headend computer through the HIC for processing and correction using the downloaded processing algorithms associated with the ID code. The headend computer then returns the corrected image information to the user's HIC for display, storage or printing (Col. 6, line 32 - Col. 9).

**C. Claims 1, 3-5, 11, 17-21, 30, and 53-59 Are Not Unpatentable Under 35
U.S.C. 103(a)**

1. Claims 53-59 are patentable under 35 U.S.C. §103(a) over Itakura in view of Hawkes in view of Marinus.

Applicant agrees with the Examiner that Itakura fails to disclose wherein said messages include at least one of warranty registration forms and questionnaires, and that Itakura fails to disclose maintaining records of camera users and corresponding camera identification. However, Itakura's failures to teach the recitations of claim 53 are even more fundamental.

First and foremost, Itakura does not even relate to digital cameras, but instead relates to a method and system for distributing messages to terminal users over a network. Therefore, Itakura fails to teach or suggest “a method for maintaining communication between a camera-related service provider and a camera user after sale of the camera...to promote an ongoing business relationship with the user,” as recited in claim 53. In addition, the messages transmitted to the camera in claim 53 are transmitted by a “camera-related service provider... after sale of the camera.” In contrast, the messages in Itakura's system are transmitted to terminals (PCs) from a message distribution apparatus that is connected to the computer of a credit card company (column 7, lines 53-62). Therefore, not only are Itakura's messages transmitted to computers, rather than to cameras, but the provider of the messages is not the provider of the terminals. Furthermore, the messages sent to the cameras in the present invention are transmitted “after sale of the camera,” whereas Itakura is directed to a conventional method of displaying advertisements for goods that users browsing the Internet are interested in, and therefore have not yet purchased.

Based on the fundamental differences, it is difficult for Applicant to understand how one skill in the art who was attempting to provide a method for a camera service provider to maintain an ongoing business relationship with buyers of the camera would look for solutions in Itakura,

which doesn't relate at all to cameras and is directed to conventional method for displaying advertisements over the Internet before users have purchased the item, rather than after.

It is also submitted that Itakura fails to teach or suggest "sorting the messages in the categories based on individual users and categories of users." Itakura teaches searching a message ID based on the users characteristics. However, it is respectfully submitted that searching a database of messages based on a user characteristic, is not the same as sorting messages in the categories because Itakura fails to teach that the messages stored in the database are sorted, or that the messages in the database are sorted after being queried.

The Examiner cited Hawkes for teaching a method and apparatus for providing messages at multiple sites in which the messages might be a warranty. However, as described above, Hawkes discloses a method for playing audio messages related to products over speakers located through locations at a store in response to a user pressing a button next to the speaker. Thus, Hawkes teaches the transmission of messages to sites within the *same facility*. Insofar as Hawkes appears unrelated to transmitting messages over the Internet to different users located wherever there is Internet access, it is respectfully submitted that there is no motivation (express or implied) to combine the teachings of Hawkes with Itakura.

However, even when Hawkes is combined with Itakura, Applicant agrees with the Examiner's admission that the combination fails to disclose maintaining records of camera users and corresponding camera identification (ID); and transmitting messages from the message center to the camera. In addition, the messages in Hawkes are displayed for products prior to sale as in Itakura, rather than "after sale," as recited in the claims of the present invention.

In the Final Office Action, the Examiner cites Maurinus for disclosing a camera manufacturer downloading correction codes with a camera ID to a headend computer, and states

that "it would have been obvious to ... modify the device in Itakura et al. and Hawkes by the teaching of Maurinus et al. in order to allow [the] user to follow-up and update [the] camera."

The purpose of the present invention, however, is not to allow a user to update the camera, as suggested by the Examiner, but to enable a camera service provider to promote an ongoing business relationship. Accordingly, it is submitted that not only would one of ordinary skill in the art not look for solutions on how to promote an ongoing business relationship with camera buyers in systems that display advertisements to prospective buyers, as in Itakura and Hawkes, but would definitely have no reason to then look to Maurinus, which teaches a method for remotely correcting image data from a camera in an interactive home environment.

Given the disparate nature of the cited references, it appears the Examiner has used the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. It is well settled that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fritch*, 972 F.2d 1260, 23 USPQ.2d 1780 (Fed. Cir. 1992).

In view of the foregoing, claims 53-59 are patentable over a combination of Itakura, Hawkes, and Maurinus.

- 2. Claims 1, 3-5, 11, 17-21, 30, are patentable under 35 U.S.C. §103(a) over Reelee in view of Ilcisin in view of Itakura et al. and Hawkes (US 6,161,122).**

The Examiner cites Reelee for disclosing an integrated digital camera apparatus. Applicant agrees with the Examiner's admission in the Final Office Action that Reelee does

not disclose an automatic signal transmission apparatus for transmitting a message request signal to a message apparatus conveying an identification camera apparatus when the transceiver is turned on. The Examiner cited Ilcisin for teaching between two video phones.

With respect to Reelee, the Final Action, the Examiner stated that Reelee teaches the limitation that the messages do not include digital image data from said digital image acquisition apparatus. This statement, however, is in direct contradiction to the disclosure of Reelee, which clearly states the “cellular telephone ... transmits digital image signals to a remote location when the camera unit is electrically coupled to the cellular telephone” (Abstract).

Applicant also agrees with the Examiner statement in the Advisory Action of June 1, 2004 that Reelee and Ilcisin “fail to specifically disclose a messaging apparatus in said camera apparatus and said message center allows said service provide [sic] to promote an ongoing business relationship with said user after sale of said camera apparatus.” The reason Reelee fails to disclose this is that Reelee’s voice messages played over the cellphone speaker indicating various operating conditions of the cellular telephone are not transmitted or received by the cellular telephone (transceiver), as claimed in the present invention.

The Examiner cited Itakura for disclosing a communication system for distributing messages such as advertisements to users of terminal equipment, and that the user may access the communication network to buy goods and that the provider can provide update information to users (Advisory Action). The Examiner stated:

Therefore, it would have been obvious... to modify the device in Reelee and Ilcisin by the teachings of Itakura in order to allow users [sic] to find advertisements for goods or services, which match their interest and advertisers can efficiently provide messages to potential users who have a high probability purchasing their goods.

It is respectfully submitted that this combination cited art teaches no more than Applicant's admitted prior art as described in the Background of the Invention, which states:

Although cameras are known that can send and receive messages, they do not provide for an on-going business relationship. A camera with message capability is described in U.S. Pat. No. 5,220,366 that can receive and display messages and transmit acknowledgment to the sender. In this patent, the goal is to minimize the number of devices a photographer needs to carry with him by integrating a photographer's pager with the camera. The pager in this patent is not configured ... for enhancement of communication between a customer and the manufacturer, retailer, service center, etc.

As described above, Itakura does not relate to digital cameras, but instead relates to a method and system for distributing messages to terminal users over a network. Based on this fundamental difference, it is difficult for Applicant to understand how one skill in the art was attempting to provide a method for a camera service provider to maintain an ongoing business relationship with buyers of the camera would look for solutions in Itakura, which doesn't relate to cameras and is directed to a conventional method for displaying advertisements over the Internet before users have purchased the item, rather than after.

Even if Itakura is combined with Reeley and Ilcisin, the combination and the admitted prior art both fail to provide a system in which messages are provided by a service provider in a manner that enables the service provider to promote an ongoing business relationship with said user *after sale of said camera* apparatus. Instead, the combination of references would provide a system that displays advertisements for goods or services that match the user's interest as they surf the Internet. In contrast, the messages displayed on the camera in the present invention include "warranty registration forms and questionnaires," which are specifically related to the purchased camera, not just any object for sale on the Internet.

The Examiner cited Hawkes for teaching a method and apparatus for providing messages at multiple sites in which the messages might be a warranty. However, as described above, Hawkes discloses a method for playing messages related to products over speakers located through locations at a store in response to a user pressing a button next to the speaker. Thus, Hawkes teaches the transmission of messages to multiple sites within the *same facility*. Insofar as Hawkes appears unrelated to transmitting messages over the Internet to different users located wherever there is Internet access, it is respectfully submitted that there is no motivation (express or implied) to combine the teachings of Reeley, Itakura, and Ilcisin.

In citing a string of four references, Reeley, Itakura, Ilcisin, and Hawkes, to reject claims 1, 3-5, 11, 17-21, 30, the Examiner has used the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious, which is impermissible hindsight reconstruction.

In view of the foregoing, it is respectfully submitted that claims 1, 3-5, 11, 17-21, 30 are patentable over Reeley, Itakura, Ilcisin, and Hawkes.

E. Summary of Arguments

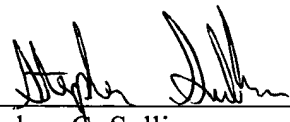
For all the foregoing reasons, it is respectfully submitted that Claims 11, 3-5, 11, 17-21, 30, and 53-59 (all the Claims presently in the application) are patentable for claiming subject matter that is not unpatentable under 35 U.S.C. §103(a). Thus, Appellant respectfully requests that the Board reverse the rejection of all the appealed Claims and find each of these Claims allowable.

Note: For convenience of detachment without disturbing the integrity of the remainder of pages of this Appeal Brief, Appellant's "APPENDIX" section is contained on separate sheets following the signatory portion of this Appeal Brief.

This Brief is being submitted in triplicate, and authorization for payment of the required Brief fee is contained in the transmittal letter for this Brief. Please charge any fee that may be necessary for the continued pendency of this application to Deposit Account No. 02-2120 (Sawyer Law Group LLP).

Respectfully submitted,
SAWYER LAW GROUP LLP

August 26, 2004
Date



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IX. APPENDIX

1. An integrated digital camera apparatus comprising:
 - (a) a housing;
 - (b) a digital image acquisition apparatus built into said housing, said digital image acquisition apparatus including image capture apparatus for converting a light image to digital image data and image storage apparatus for storing said digital image data;
 - (c) a messaging apparatus independent of said digital image acquisition apparatus built into said housing, said messaging apparatus including
 - (i) transceiver apparatus limited to sending and receiving messages through a communications network, said messages not including digital image data from said digital image acquisition apparatus;
 - (ii) automatic signal transmission apparatus for automatically causing said transceiver apparatus to transmit a message request signal to said messaging apparatus conveying an identification of said camera apparatus when said transceiver is turned on;
 - (iii) code apparatus for selectively receiving messages sent to said transceiver by a message center from a service provider, wherein said messages include advertisements and at least one of warranty registration forms and questionnaires, and wherein said service provider includes any combination of a billing center, a retailer, and a camera manufacturer; and
 - (iv) message display apparatus for communicating said messages to a user of said camera apparatus in graphic or audio form; whereby said messaging

apparatus in said camera apparatus and said message center allows said service provider to promote an ongoing business relationship with said user after sale of said camera apparatus.

2. (Canceled).

3. A digital camera apparatus as recited a claim 1 further comprising user activated apparatus for causing said transceiver to transmit a message request signal to said message center conveying an identification of said camera.

4. A digital camera apparatus as recited a claim 1 further comprising apparatus disabling said automatic signal transmission apparatus when a user does not want to receive messages.

5. A digital camera apparatus as recited in claim 1 wherein said code apparatus includes identification of a model number of said camera.

6-10 (Canceled).

11. A digital camera apparatus as recited in claim 1 further comprising interactive message response apparatus for responding to a question received in a message from said message center.

12-16 (Canceled).

17. A digital camera message system comprising:
- (a) a message center including
 - (i) apparatus for collecting, preparing and sorting messages to be sent to a transceiver in an assembly including a digital camera, wherein said messages include advertisements and at least one of warranty registration forms and questionnaires from a service provider, wherein said service provider includes any combination of a billing center, a retailer, and a camera manufacturer;
 - (ii) first communication apparatus responsive to reception of a message request signal conveying a camera identification for transmitting said messages to said transceiver along with a code; and
 - (b) an integrated hand held assembly including
 - (i) a housing;
 - (ii) a digital image acquisition apparatus built into said housing, said digital image acquisition apparatus including image capture apparatus for converting a light image to digital image data and image storage apparatus for storing said digital image data;
 - (iii) transceiver apparatus limited to sending and receiving messages through a communications network, said messages not including digital image data from said digital image acquisition apparatus;
 - (iv) code apparatus including apparatus responsive to said code for selectively processing messages sent to said camera;
 - (v) automatic signal transmission apparatus for automatically causing said transceiver apparatus to transmit a message request to said message center conveying an

identification of said integrated hand held assembly when said transceiver apparatus is turned on; and

(vi) message display apparatus for communicating said messages to a user of said integrated hand held assembly in graphic or audio form;

whereby said message center allows said service provider to promote an ongoing business relationship with said user after sale of said integrated hand held assembly.

18. A digital camera message system as recited in claim 17 wherein said message center includes a capability to send a selected message to a specific said assembly based on said code.

19. A digital camera message system as recited in claim 17 wherein said message center further includes a capability to send a message simultaneously to a plurality of assemblies by transmitting a corresponding particular said code.

20. A digital camera message system as recited in claim 17 wherein said message center further includes a capability to prioritize messages as part of a single packet of multiple said messages.

21. A digital camera message system as recited in claim 17 wherein said assembly further includes means for disabling said automatic signal transmission apparatus when a user does not want to receive messages.

22-29 (Canceled).

30. A digital camera system as recited in claim 17 wherein said assembly further includes interactive message response apparatus for responding to a question received in a message from said message center.

31-35 (Canceled).

36. A method of communication as recited in claim 34 wherein said priority values include an order of display of said messages.

37-52 (Canceled).

53. A method for maintaining communication between a camera-related service provider and a camera user after sale of the camera, the method comprising the steps of:

providing a message center for:

maintaining records of camera users and corresponding camera identification

(ID),

storing messages that include advertisements and at least one of warranty

registration forms and questionnaires, and

sorting the messages into categories based on individual users and categories of

users; and

transmitting from said message center to the camera, messages that match the categories associated with the user, such that the messages are communicated to the user of the camera in

graphical or audio form, thereby providing the service provider with an opportunity to promote an ongoing business relationship with the user.

54. The method of claim 53 wherein the message center transmits the messages to the camera in response to receiving the camera ID from the camera.

55. The method of claim 54 wherein the message center transmits each message with an ID code, and wherein the camera receives and stores only the messages having an ID code that corresponds to the camera.

56. The method of claim 55 wherein the user can subscribe with the message center to receive messages for selected categories.

57. The method of claim 55 wherein the user may select an option from the camera not to receive any messages.

58. The method of claim 53 wherein the message center continuously transmits generic messages to a plurality of cameras.

59. The method of claim 53 wherein the message center packages personal messages for the user and for a particular camera model together with generic messages, and transmits the package to the camera.